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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,718	06/25/2001	Dale W. Malik	BELL-0105/01031	2081
38952	7590	01/23/2006	EXAMINER	
WOODCOCK WASHBURN LLP ONE LIBERTY PLACE - 46TH FLOOR PHILADELPHIA, PA 19103			NGUYEN, QUANG N	
		ART UNIT	PAPER NUMBER	
			2141	

DATE MAILED: 01/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/888,718	MALIK, DALE W.	
	Examiner	Art Unit	
	Quang N. Nguyen	2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 05 December 2005.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,3-12 and 15-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,3-12 and 15-26 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 25 June 2001 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

Detailed Action

1. This Office Action is in response to the Amendment filed on 12/05/2005. Claims 1, 8, 16, 18 and 21 have been amended. Claims 2 and 13-14 have been canceled. Claims 1, 3-12 and 15-26 remain for examination.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. **Claims 1, 8, 16, 18 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

4. Claims 1, 8, 16, 18 and 21 recite the limitation "by the recipient" in "if the email has a vendor registration code that was previously assigned to the email source and the email has a vendor registration purpose code that was previously assigned by the recipient to the email source, presenting the email with other emails having vendor registration codes". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1, 3, 7 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greenstein (US 6,266,692), in view Schiavone et al. (US 2002/0120702 A1), herein after referred as Schiavone.**

7. As to claims 1 and 3, Greenstein teaches a method for filtering email using a header-based password, comprising:

receiving an email from an email source (*receiving advertisement emails from an advertiser as in steps 102-104*) (Greenstein, Fig. 1 and C3: L.39-42);

identifying whether the email has a vendor registration code (*i.e., passcode*) for identifying a vendor from whom the email was forwarded (*email server checks passcodes of all received emails as in step 106*) (Greenstein, Fig. 1 and C3: L42-44);

if the email has a vendor registration code that was previously assigned by a recipient to the email source, presenting the email with other emails having vendor registration codes (*determining if the received email has a valid passcode provided by*

the user, the email server approves the email at step 108 and sends the email to the user's mail inbox at step 110) (Greenstein, Fig. 1, C2: L24-27 and C3: L40-49); and

if the email does not have a vendor registration code that was previously assigned by the recipient to the email source, sending a message to the email source (if a sender did not specify a passcode previously provided by the user when sending to the user who requires such passcode, the unwanted/unapproved email is stored in a temporary storage until deleted or approved and the mail server may additionally send a reply email back to the sender) (Greenstein, C2: L24-39 and C3: L52-67).

However, Greenstein does not explicitly teach identifying whether the email has a vendor registration purpose code for identifying the purpose of the email and presenting the email with other emails having the same vendor registration code and vendor registration purpose code.

In a related art, Schiavone teaches a system and method for categorization and categorized display of messages in a recipient's inbox which is divided into sections acting like multiple inboxes, *each section displaying messages falling in a certain corresponding category (i.e., presenting the email with other emails having the same vendor registration purpose code)*, wherein the new email message is associated with a category by *reading of a message identifier from header information of the new email message (identifying whether the email has a message identifier associated with a certain corresponding category, i.e., identifying a vendor registration purpose code identifying the purpose of the email) and determining whether the message identifier matches the category identifier (i.e., determining whether the email has a valid vendor registration purpose code)* (Schiavone, Figs. 6-7 and [0054-0055]).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of Greenstein and Schiavone to include a vendor registration purpose code to identify the purpose of the email and presenting the email with other emails having the same vendor registration code and vendor registration purpose code since such methods were conventionally employed in the art to allow the system to enhance the efficacy of the email messaging and to counteract dilution caused by receipt of numerous, unimportant email messages by segregating mail into meaningful categories (*i.e., purposes*) (Schiavone, [0048]).

8. Claim 7 is a corresponding computer readable medium claim of method claim 1; therefore, it is rejected under the same rationale.
9. Claims 16-17 are corresponding method claims of method claim 1; therefore, it is rejected under the same rationale.
10. **Claims 4-6, 8-12, 15 and 18-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greenstein-Schiavone, and further in view of Paul (US 5,999,932).**
11. As to claims 4-5, Greenstein-Schiavone teaches the method of claim 1, but does not explicitly teach identifying the username and the source from which the email was forwarded and identifying whether the username and source of the email message identify a valid contact.

In a related art, Paul teaches a system and method for filtering unsolicited emails generating and storing a user inclusion list including identification data (*such as list of valid/approved email addresses or groups of email addresses organized by domain*) for identifying email desired by the user, wherein upon receipt of an email message, the email filter retrieves data from selected fields (*such as FROM, TO, CC, etc.*) of the received email message and compares the retrieved data with data stored in the corresponding category of the user inclusion list (*i.e., identifying whether the username and source identify a valid contact*) (Paul, C7: L52-62 and C8: L17-31).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of Greenstein-Schiavone and Paul to check whether the username and source of the email message identify a valid contact since such methods were conventionally employed in the art to sort out email messages by comparing one or more predetermined data fields (*such as username and domain*) of each email message with data stored in an automatically updated database of acceptable addresses and domains (*inclusion lists*) to determine if email messages are of potential interest to the user or just "junk" or "spam" email messages.

12. As to claim 6, Greenstein-Schiavone-Paul teaches the method of claim 5, further comprising identifying a source category corresponding to the source identified for the email (*i.e., identifying the "FROM" field has a domain that matches one of a pre-defined list of domains that assured to be junk-free such as corporations or government organizations*) (Paul, C9: L34-45).

13. Claim 8 is a corresponding combination method claim of method claims 1 and 4-6; therefore, it is rejected under the same rationale.

14. As to claims 9-10, Greenstein-Schiavone-Paul teaches the method of claim 8, further comprising if the email is not from a source in a contact list and does not have a vendor registration code that was previously assigned to the email source (*if there is no passcode, the email is held temporary in a holding tank, until the receiver approves to receive the email*) (Greenstein, C3: L52-57), presenting the email with other emails that are not from a source that is identified in a contact list and do not have a vendor registration code (*i.e., placing the message in a folder according to its status as “OK”, “NEW” or “JUNK”, i.e., not “OK”*) (Paul, C9: L7-47).

15. As to claims 11-12, Greenstein-Schiavone-Paul teaches the method of claim 9, further comprising parsing the email to identify at least one of the following: a user name from whom the email was forwarded; and a source from which the email was forwarded and further comprising comparing the username and source to the contact list to determine if the email is from a source that is identified in the contact list (*upon receipt of an email message, the email filter retrieves data from the "FROM" field of the received email and compares the field data retrieved from the received message with data stored in the corresponding category of the inclusion list*) (Paul, C8: L17-27).

16. Claim 15 is a corresponding computer readable medium claim of method claim 8; therefore, it is rejected under the same rationale.

17. Claims 18-20 are corresponding system claims of method claims 8-10; therefore, they are rejected under the same rationale.

18. Claims 21-26 are corresponding method claims of method claims 4 and 8-10; therefore, they are rejected under the same rationale.

Response to Arguments

19. In the remarks, Applicant argued in substance that

(A) Prior Arts do not teach or suggest “the use of a vendor registration purpose code that was previously assigned by a recipient”, as claimed in claim 1.

As to point (A), **Greenstein** teaches a method and system for blocking all unwanted email (Spam) using a header-based password, wherein a recipient/user provides a “passcode” to all potential senders so that when sending an email, a sender must specify the passcode which was provided by the recipient in a mail header in order for the email server to check and approve the email and then send/forward the email to the user’s inbox (**Greenstein, Fig. 1, C2: L24-27 and C3: L40-49**).

While **Greenstein** teaches the use of the “passcode” to identify/block unwanted email (Spam), in a related art, **Schiavone** teaches a system and method for categorization and categorized display of messages in a recipient's inbox which is

divided into sections acting like multiple inboxes, each section displaying messages falling in a certain corresponding category (i.e., *presenting the email with other emails having the same vendor registration purpose code*), wherein the new email message is associated with a category by reading of a message identifier from header information of the new email message (*identifying whether the email has a message identifier associated with a certain corresponding category, i.e., identifying a vendor registration purpose code identifying the purpose of the email*) and determining whether the message identifier matches the category identifier (i.e., *determining whether the email has a valid vendor registration purpose code*) (**Schiavone, Figs. 6-7 and [0054-0055]**).

Therefore, it is obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of **Greenstein** and **Schiavone** to enable the recipient/user to provide a “passcode” to potential senders to include in the email header to identify the email source and/or the email category to allow the system to enhance the efficacy of the email messaging and to counteract dilution caused by receipt of numerous, unimportant email messages by segregating mail into meaningful categories (i.e., *prioritizing emails based on categories/purposes*) (**Schiavone, [0048]**).

(B) “Neither Greenstein nor Schiavone offers a teaching, suggestion or motivation to combine the references particularly since Schiavone does not disclose the recipient assigning any codes at all”.

As to point (B), in response to applicant's arguments against the references individually that “Schiavone does not disclose the recipient assigning any codes at all”, one cannot show nonobviousness by attacking references individually where the

rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, **Greenstein** teaches the use of the “passcode” to identify/block unwanted email (Spam) and **Schiavone** teaches a system and method for categorization and categorized display of messages in a recipient's inbox which is divided into sections acting like multiple inboxes, each section displaying messages falling in a certain corresponding category, wherein the new email message is associated with a category by reading of a message identifier from header information of the new email message and determining whether the message identifier matches the category identifier (**Schiavone**, Figs. 6-7 and [0054-0055]). Therefore, it would have been obvious to one having ordinary skill in the art to combine the teachings of Greenstein and Schiavone to use the “passcode” provided/assigned by the recipient to identify the source and category of the message (as a message identifier) to prioritize and categorize display of messages in a recipient's inbox in accordance with the

message's category to enhance the efficacy of the email messaging and to counteract dilution caused by receipt of numerous, unimportant email messages by segregating mail into meaningful categories (*i.e., prioritizing emails based on categories/purposes*) (**Schiavone, [0048]**).

20. Applicant's arguments as well as request for reconsideration filed on 12/05/2005 have been fully considered but they are not deemed to be persuasive.

21. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang N. Nguyen whose telephone number is (571) 272-3886.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's SPE, Rupal Dharia, can be reached at (571) 272-3880. The fax phone number for the organization is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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